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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,829	03/28/2001	Tatsuya Tamaru	P20837	1507
7055	7590	01/03/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			LETT, THOMAS J	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,829

Applicant(s)

TAMARU, TATSUYA

Examiner

Thomas J. Lett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2,3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the term "in" should be removed from p49, line 15. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 14, 18, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "said identification number" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "said identification number" in line 16. There is insufficient antecedent basis for this limitation in the claim.

Claim 25 recites the limitation "the calling" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

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351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7, 9-13, 16-17, and 20-24, 26, and 27 are rejected under 35

U.S.C. 102(e) as being anticipated by Shibata (US Patent 6,825,955 B1).

With respect to claim 1, Shibata discloses a facsimile apparatus 1 capable of internet transmission/reception (internet facsimile 1) using dialup (Fig. 1).

a mail transmitter (an e-mail service unit 16 col. 6, lines 51-54) for transmitting said email to said Internet; and

a notice sender (a third e-mail service unit 18 col. 9, lines 19-22) for sending notice including the fact that said e-mail is transmitted to said receiver via a telephone network when said mail transmitter transmits said e-mail and sent data information relating to send data included in said e-mail.

With respect to claim 2, Shibata discloses that said notice sender adds reception timing information (adds a transmission time 54 representing a date and time of an execution of E-mail transmission) relating to timing at which a destination receives said e-mail from said Internet to said notice including the fact that said e-mail is transmitted to said receiver via said telephone network when said mail transmitter transmits said e-mail.

With respect to claim 3, Shibata discloses send data is image information (the facsimile apparatus 1 transmits the e-mail 40 including the attachment file 40a (image) to the Internet service 4 (col. 8, lines 45-46).

With respect to claim 4, Shibata discloses notice sender sends notice based on a facsimile communication protocol (the third E-mail service unit 18 transmits the e-mail

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transmission information to the local communications terminal using the facsimile protocol manager 14 (col. 7, lines 1-4).

With respect to claim 5, Shibata discloses that a notice sender (third E-mail service unit 18) sends notice in phase B and/or phase C (transmits the e-mail transmission information to the local communications terminal using the facsimile protocol manager 14 (col. 7, lines 1-4)).

With respect to claim 6, Shibata discloses a notice sender sends notice using a call procedure (that after transferring the SETUP message to the local facsimile apparatus 6 in Step S002, the ISDN sends in Step S003 a CALL PROCEEDING message back to the facsimile apparatus 1. The local facsimile apparatus 6 receives the SETUP message sent from the ISDN using the network controller thereof and recognizes the E-mail transmission notice (col. 9, lines 46-52).

With respect to claim 7, Shibata discloses notice sender sends notice in writing by use of facsimile communication (facsimile main controller 10 further includes an image writing unit for printing onto a recording sheet (not shown) facsimile image data (col. 6, lines 5-6)).

With respect to claim 9, Shibata discloses that the first E-mail service unit 16 sends a user identification for identifying a sender of the E-mail 40 and a command for sending the E-mail 40 (col. 8, lines 34-35). After completing the transmission of E-mail, the first E-mail service unit 16 performs an operation for disconnecting the line (stop the calling) with the Internet server 4 using the network controller 15 (col. 8, lines 54-57).

With respect to claim 10, Shibata discloses a facsimile apparatus 1 comprises an e-mail service unit 16 for transmitting/receiving email via the internet (col. 6, lines 51-54), which reads on a mail transmitter for transmitting said email to said Internet; and

a third e-mail service unit 18 of the facsimile apparatus 1 sends an e-mail transmission notice (sending notice) to the local facsimile apparatus 6 via the public telephone network 2 (col. 9, lines 19-22).

With respect to claim 11, Shibata discloses that each notice includes a plurality of information sets in rows which include a notice type 51 representing types of notices such as a transmission time 54 (timing information) representing a date and time of an execution of E-mail transmission (col. 9, lines 33-35).

With respect to claim 12, Shibata discloses an internet facsimile apparatus 1 capable of transmission/reception;

a dial-up device (dial-up communications controller 13) accessing the Internet via a telephone network;

a mail receiver (facsimile apparatus 1 comprises an e-mail service unit 16) for receiving e-mail from said Internet via said dial-up device;

a notice receiver (local facsimile 6 sends an E-mail receiving error notice to the facsimile apparatus 1) for receiving mail transmission notice including the fact that said e-mail has been transmitted via said telephone network from a transmitter as a destination of said e-mail and sent data information relating to send data included in said e-mail; and

a controller (facsimile apparatus 1 comprises an e-mail service unit 16 for transmitting/receiving email) for causing said mail receiver to receive said e-mail when determining that said send data is receivable from said sent data information received said notice receiver (col. 6, lines 51-54).

With respect to claim 13, Shibata discloses that the mail transmission notice further includes reception information relating to timing at which said e-mail is received from said Internet, and said controller causes said mail receiver to receive said e-mail in accordance with said reception timing information (each notice includes a plurality of information sets in rows which include a notice type 51 representing types of notices such as a transmission time 54 (timing information) representing a date and time of an execution of E-mail transmission (col. 9, lines 33-35)).

With respect to claim 16, Shibata discloses an internet facsimile apparatus 1 capable of transmission/reception;

receiving mail transmission notice (using a transmission/receiving status manager 11) that notifies the fact that said e-mail has been transmitted via said telephone network from a transmitter as a destination of said e-mail and sent data information relating to send data included in said e-mail; and

accessing the Internet by dialup (using dial-up communications controller 13) via said telephone line to receive said e-mail from said Internet when determining that said send data is receivable from said sent data information.

With respect to claim 17, Shibata discloses an internet facsimile apparatus 1 capable of transmission/reception;

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mail transmission notice further includes reception information relating to timing at which said e-mail is received from said Internet (each notice includes a plurality of information sets in rows which include a notice type 51 representing types of notices such as a transmission time 54 (timing information) representing a date and time of an execution of E-mail transmission (col. 9, lines 33-35)), and

at the time of receiving said e-mail, access to said Internet is performed by dialup (using dial-up communications controller 13) via said telephone line in accordance with said reception information to receive e-mail from said Internet.

With respect to claim 20, Shibata discloses a facsimile apparatus 1 comprises an e-mail service unit 16 for transmitting/receiving email via the internet (col. 6, lines 51-54), which reads on a mail transmitter for transmitting said email to said Internet; and

a third e-mail service unit 18 (notice sender) of the facsimile apparatus 1 sends an e-mail transmission notice to the local facsimile apparatus 6 via the public telephone network 2 (col. 9, lines 19-22).

and that each notice includes a plurality of information sets in rows which include a notice type 51 representing types of notices such as a transmission time 54 (timing information) representing a date and time of an execution of E-mail transmission.

Claim 21 is a method claim and is rejected for the same reason as that of claim 20.

With respect to claim 22, Shibata discloses an internet facsimile apparatus 1 capable of transmission/reception;

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a dial-up device (dial-up communications controller 13) accessing the Internet via a telephone network;

a mail receiver (facsimile apparatus 1 comprises an e-mail service unit 16) for receiving e-mail from said Internet via said dial-up device;

a notice receiver (local facsimile 6 sends an E-mail receiving error notice to the facsimile apparatus 1) for receiving mail transmission notice including the fact that said e-mail has been transmitted via said telephone network from a transmitter as a destination of said e-mail and sent data information relating to send data included in said e-mail; and

a controller (facsimile apparatus 1 comprises an e-mail service unit 16 for transmitting/receiving email) for causing said mail receiver to receive said e-mail when determining that said send data is receivable from said sent data information received said notice receiver (col. 6, lines 51-54).

With respect to claim 23, Shibata discloses an internet facsimile apparatus 1 capable of transmission/reception;

receiving mail transmission notice that notifies the fact that said e-mail has been transmitted via said telephone network from a transmitter as a destination of said e-mail and reception timing information relating to timing at which said e-mail is received from said Internet; and

accessing the Internet by dialup via said telephone line in accordance with said reception timing information to receive said e-mail from said Internet.

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With respect to claim 24, Shibata discloses an internet facsimile apparatus 1 capable of transmission/reception;

a dial-up device (dial-up communications controller 13) accessing the Internet via a telephone network;

a mail receiver (facsimile apparatus 1 comprises an e-mail service unit 16) for receiving e-mail from said Internet via said dial-up device;

a notice receiver (local facsimile 6 sends an E-mail receiving error notice to the facsimile apparatus 1) for receiving mail transmission notice including the fact that said e-mail has been transmitted via said telephone network from a transmitter as a destination of said e-mail and sent data information relating to send data included in said e-mail; and

a controller (facsimile apparatus 1 comprises an e-mail service unit 16 for transmitting/receiving email) for causing said mail receiver to receive said e-mail when determining that said send data is receivable from said sent data information received said notice receiver (col. 6, lines 51-54).

With respect to claim 26, Shibata discloses an internet facsimile apparatus 1 capable of transmission/reception;

a dial-up device (dial-up communications controller 13) accessing the Internet via a telephone network;

a sender ID recognizer (terminal registration memory 12) for receiving sender identification number notice from an exchange provided in said telephone network to recognize a sender ID; and

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a controller (facsimile main controller 10) for comparing said sender ID recognized by said sender ID recognizer with a mail sender number preregistered to cause said mail receiver to said e-mail when both match each other (two facsimile devices 6 and 1 using user Ids in a subscriber fashion in order to allow transmission. These user Ids are validated(matched) by using a terminal information list 30 system in order to allow communication between the devices 1 and 6 (col. 7, lines 35-39)).

With respect to claim 27, Shibata discloses an internet facsimile apparatus 1 capable of transmission/reception;

receiving sender identification number notice from an exchange provided in a telephone network to recognize a sender identification number; and comparing said recognized sender identification number with a mail sender number preregistered to access the Internet by dialup via said telephone network when both match each other, whereby receiving e-mail from said Internet (two facsimile devices 6 and 1 using user Ids in a subscriber fashion in order to allow transmission. These user Ids are validated(matched) by using a terminal information list 30 system in order to allow communication between the devices 1 and 6 (col. 7, lines 35-39)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 8, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shibata (US Patent 6,825,955 B1).

With respect to claim 8, Shibata doesn't specifically disclose transmitting a given number indicating that said e-mail has been transmitted in place of an identification number.

However, Examiner takes Official Notice that Shibata does disclose using the designators "NG", "OK", and "CF" to indicate notification that said e-mail has been transmitted (col 12, lines 53-64).

It would be obvious to one of ordinary skill in the art to use the designators "NG", "OK", and "CF", instead of transmitting a given number to obtain the invention as specified in claim 8.

With respect to claims 15 and 19, Shibata doesn't specifically disclose a caller ID recognizer that receives caller identification number notice from a facsimile control device for receiving image information using facsimile communication via said telephone network and an exchange provided in said telephone network, and recognizes a caller ID, wherein said controller compares said caller ID recognized by said caller ID recognizer with a mail sender number preregistered, and causes said mail receiver to receive said e-mail when both match each other.

However, Examiner takes Official Notice that Shibata does disclose a similar method where two facsimile devices 6 and 1 using a user ID in a subscriber fashion in order to allow transmission between the two facsimile devices. These user IDs are

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validated (matched) by the subscriber system in order to allow communication between the devices 1 and 6 (col. 7, lines 35-39).

It would therefore have been obvious to one of ordinary skill in the art to use the apparatus of Shibata to obtain the invention as specified in claim 15.

Claim 19 is a method claim and is rejected for the same reasoning as that of claim 15.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Lett whose telephone number is 703-305-8733. The examiner can normally be reached on 7-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or Faxed to:

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be brought to:

Crystal Park II
2121 Crystal Drive
Arlington, VA Sixth Floor (Receptionist).

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TJL

TJL

KAWilliams

KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER